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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,522	06/04/2001	Hideyuki Sakamoto	NEC01P072-TSe	3317
30743 7590 12/27/2006 WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			EXAMINER DUNHAM, JASON B	
			ART UNIT	PAPER NUMBER
			3625	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/27/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/872,522

Applicant(s)

SAKAMOTO, HIDEYUKI

Examiner

Jason B. Dunham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant amended claims 1,9,34,40, and 56 in the response filed July 14, 2006 to the office action dated May 3, 2006. Claims 1-61 are pending. The examiner's office action dated May 3, 2006 was in response to applicant's remarks and amendments filed February 14, 2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie (U.S. Patent No. 5,970,469) in view of Cooper (U.S. Patent No. 5,757,907).

Referring to claim 1. The combination of Scroggie and Cooper discloses a method of trial purchase for allowing users of a plurality of terminals connected to commodity providing means through a network to experience a purchase procedure of a commodity provided from said commodity providing means through said network, said method comprising the steps of:

- Displaying information for a user about a commodity provided from said commodity providing means for trial purchase on one of said terminals (Scroggie: column 7, line 53 – column 8, line 2);

- Determining by a computer whether or not the user is eligible for a trial purchase procedure, said determination being made from a database recording prior uses of said commodity providing means, including prior uses of said trial purchase procedure, said prior uses being counted against said eligibility (Cooper: column 12, lines 4 – 65);
- If the user is determined to be eligible, performing by a computer for the user using said terminal said trial purchase procedure and recording in said database said performance as a prior use of said trial purchase procedure by said user (Scroggie: column 4, lines 33-50); and
- If the user is determined not to be eligible notifying by a computer the user at said terminal that said trial purchase procedure cannot be provided (Scroggie: column 4, lines 33-50).

Scroggie does not expressly disclose whereby a purchase incentive is a trial purchase. Cooper discloses a method wherein the "incentive" may be a trial period (Cooper: column 2, lines 25-63). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Scroggie to provide a purchase incentive in the form of a trial purchase and to count prior use by users against eligibility of a trial purchase, as taught by Cooper, in order to "allow the user a temporary trial period without subjecting the software product to unnecessary risks of piracy or unauthorized utilization beyond the trial interval" (Cooper: column 2, lines 25-31).

Referring to claim 2-4. The combination of Scroggie and Cooper further discloses a method comprising the steps of:

- Storing a delivery destination in a previous purchase of the user (Scroggie: abstract) and;
- Providing delivery of said commodity for trial purchase to said previously stored destination when said commodity is specified on said terminal (Scroggie: abstract).
- Designating said previously stored destination or a newly designated destination as a destination of said commodity (Scroggie: abstract).
- Storing said newly designated destination (Scroggie: abstract).

Referring to claims 5-8. Scroggie does not expressly disclose a method of providing a commodity for trial purchase free of charge. Cooper discloses a method wherein said commodity is free of charge (Cooper: column 12, lines 4-25). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Scroggie to provide a purchase incentive in the form of a free trial purchase, as taught by Cooper, in order to "allow the user a temporary trial period without subjecting the software product to unnecessary risks of piracy or unauthorized utilization beyond the trial interval" (Cooper: column 2, lines 25-31).

Referring to claims 9-22. Claims 9-22 are rejected under the same rationale set forth above.

Referring to claims 23-32. The combination of Scroggie and Cooper further teaches system comprising backup means for holding the commodity information stored in said commodity information storing means (Scroggie: figure 15).

Referring to claims 33 and 61. Claims 33 & 61 are rejected under the same rationale set forth above.

Referring to claim 34. The combination of Scroggie and Cooper further discloses a method of gathering customer information on users of a plurality of terminals from said terminals connected to a network, said method comprising the steps of:

- Providing said terminal with information on a commodity for trial purchase to allow experience of a procedure of commodity purchase through said network (Scroggie: abstract);
- Causing entry of customer information on a user who makes an order for said commodity based on said commodity information into said terminal when said order is received (Scroggie: abstract);
- Determining by a computer whether or not said user is eligible for trial purchase of said commodity, said determination being made from a database recording prior use by said user of said procedure of commodity purchase through said network, including prior purchases of a commodity for trial purchase, said prior uses being counted against said eligibility (Cooper: column 12, lines 4-65);
- If the user is determined to be eligible, placing said received order and recording said order in said database as a prior purchase of a commodity for trial purchase (Scroggie: figure 5); and

- If the user is determined not to be eligible, notifying the user at said terminal that said received order cannot be placed (Scroggie: column 4, lines 33-50). The examiner notes that Scroggie discloses a method wherein certain discounts or order cannot be placed unless customer information is entered and checked against a database for eligibility.

Scroggie does not expressly disclose whereby a purchase incentive is a trial purchase. Cooper discloses a method wherein the "incentive" may be a trial period (Cooper: column 2, lines 25-63). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Scroggie to provide a purchase incentive in the form of a trial purchase and to count prior use by users against eligibility of a trial purchase, as taught by Cooper, in order to "allow the user a temporary trial period without subjecting the software product to unnecessary risks of piracy or unauthorized utilization beyond the trial interval" (Cooper: column 2, lines 25-31).

Referring to claim 35. The combination of Scroggie and Cooper further discloses a method of gathering customer information wherein said customer information is previously stored and said previously stored customer information is updated when said commodity for trial purchase is ordered on said terminal (Scroggie: column 9, lines 29-40 & figure 9).

Referring to claim 36. The combination of Scroggie and Cooper further discloses a method of gathering customer information comprising the steps of storing the name of

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said commodity for trial purchase in correspondence with the customer information of said user who ordered said commodity (Scroggie: column 6, lines 1-18).

Referring to claims 37-39. Claims 37-39 are rejected under the same rationale set forth above.

Referring to claims 40-55. Claims 40-55 are rejected under the same rationale set forth above.

Referring to claims 56-59. Claims 56-59 are rejected under the same rationale set forth above.

Referring to claims 60-61. The combination of Scroggie and Cooper further teaches a method and system comprising the steps of:

- Displaying a price of a free commodity (Cooper: column 10, lines 34-65); and
- Displaying a page for selecting a payment method (Scroggie: abstract). The examiner notes that Scroggie discloses a method of entering a credit or check card ID number.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method and system of Scroggie to have included displaying a price of a free commodity, as taught by Cooper, in order to show a user what the trial period commodity will cost for subsequent purchase (Cooper: column 10, lines 3-65).

Response to Arguments

Regarding applicant's arguments that Scroggie does not disclose a database that records prior uses of a trial purchase procedure and an eligibility determination that depends upon these records of prior use, the examiner notes that these arguments are moot in view of the new grounds of rejection. Regarding applicant's argument that Scroggie does not disclose notification of the user in the event of a non-eligibility determination, the examiner notes column 4, lines 47-50 of Scroggie disclosing, "If the customer elects not to provide the customer ID to the on-line system, these more targeted incentives will not be available to that customer."

Applicant's arguments with respect to amended claims 1,9,34,40, and 56 have been considered but are moot in view of the new ground(s) of rejection. The combination of Scroggie and Cooper discloses all limitations of the claims and the applicant's arguments regarding the teaching of determining whether a user is eligible for a trial purchase wherein said prior uses are counted against said eligibility are discussed above in the rejection of claim 1. The dependent claims of the noted amended independent claims are rejected under the same rationale set forth above.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


YOGESH C. GARG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD
Patent Examiner
12/13/06